

(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/560,758 )  
Confirmation : 5495 )  
Applicants : MEYER et al. )  
I.A. Filed : June 24, 2004 )  
Title: METHOD FOR )  
PRODUCING A FIRE )  
PROTECTION GLAZING )  
Art Unit : Not yet assigned )  
Examiner : Not yet assigned )  
Atty Docket : 30882/41723 )  
Customer No. : 04743 )

**STATEMENT OF FACTS UNDER 37 C.F.R. § 1.47(a)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The undersigned hereby states as follows:

1. I am employed as a paralegal assistant in the firm Jostarndt Patentanwalts-AG of Aachen, Germany, European patent counsel for Scheuten Glasgroep BV, which holds rights in the above-identified patent application.

2. In my capacity as a paralegal assistant, I assist Dr. Hans-Dieter Jostarndt, a patent agent with the firm in communicating with the assignee, the inventors of the application, and with U.S. patent counsel handling the application (Marshall, Gerstein & Borun LLP, Chicago).

3. I make this statement to provide facts known to me concerning Professor Gerhard Meyer's refusal to sign an inventor's declaration for the above-identified patent application.



4. Gerhard Meyer is one of six named co-inventors of the above-identified patent application. The other named co-inventors have executed declarations for patent application for themselves and on behalf of their non-signing co-inventor. Copies of the declarations are submitted herewith as Appendix A.

5. Gerhard Meyer's last-known residential address is:

Alte Delogstrasse 26  
46483 Wesel  
Germany

6. Professor Meyer is represented by counsel identified below (see also letter attached as Appendix C):

Doris Vorloeper  
GTW Attorneys  
Benzenbergstrasse 39-47  
40219 Düsseldorf  
  
Germany

7. On behalf of Jostarndt Patentanwalts AG, I sent Professor Meyer a inventor's declaration on May 15, 2006. A complete copy of the above-identified patent application has been sent to Professor Meyer with our letter dated June 14, 2004 (international filing date) along with an inventor's declaration which has been signed by Professor Meyer on July 19, 2004.

8. On July 6 and 9, 2006, Professor Meyer responded to our letter of May 15, 2006 inquiring about the filing deadline for the declaration in this and other patent applications. See e-mail chain attached as Appendix B, provided in the original German language and as an English-language translation.

9. On July 14, 2006, on behalf of Jostarndt Patentanwalts AG, I notified Professor Meyer that the original deadline had passed, and requested that the declaration (among other documents) be sent immediately for filing in the U.S. Patent and Trademark Office. See e-mail chain attached as Appendix B.




10. Subsequently, attorneys Geyer & Borchert for our client Scheuten Glasgroep (assignee of the above-identified application), received a letter dated July 18, 2006, from Professor Meyer's attorney Doris Vorloeper, Appendix C, provided in the original German language and as an English-language translation. In that letter, the attorney states that Professor Meyer is "ready to provide the required signature" but that "first some questions must be clarified." The letter proceeds to make demands for payments on a contractual matter.

11. On behalf of Jostarndt Patentanwalts AG, I requested that the attorneys for our client, the assignee Scheuten Glasgroep, summarize the correspondence with Professor Meyer attempting to obtain the executed inventor's declaration from him. The response letter of October 9, 2006, signed by Klaus-Peter Raabe and attached as Appendix D, is self-explanatory.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: Nov. 03, 2006  
Aachen, Germany

  
\_\_\_\_\_  
Christine Davids  
Jostarndt Patentanwalts AG



**Appendix A**  
**to Statement of Facts Under 37 C.F.R. § 1.47(a)**  
**by Christine Davids**



## DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name; I believe that I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled "METHOD FOR PRODUCING A FIRE PROTECTION GLAZING," the specification of which was filed on June 24, 2004, as Application Serial No. PCT/EP2004/006897 (U.S. Serial No. 10/560,758) and was amended on December 14, 2005. I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose to the Patent and Trademark Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56.

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Priority Claimed

03015013.0

(Application Serial Number)

EP

(Country)

2 July 2003

(Day/Month/Year Filed)

☒

Yes

☐

No

I hereby claim the benefit under 35 U.S.C. §119(e) of any United States provisional application listed below:

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I hereby claim the benefit under 35 U.S.C. §120 of any United States application or international application designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior application in the manner provided by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56 which occurred between the filing date of the prior application and the national or international filing date of this application:

(Application Serial Number)

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(Status-Patented, Pending or Abandoned)

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POWER OF ATTORNEY: I hereby appoint as my attorneys, with full powers of substitution and revocation, to prosecute this application and transact all business in the Patent and Trademark Office connected therewith:

All practitioners at Customer Number 04743

Send correspondence to: James P. Zeller

FIRM NAME  
Marshall, Gerstein & Borun LLP


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233 South Wacker Drive

CITY & STATE  
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
Full Name of First or Sole Inventor Gerhard Meyer	Citizenship Germany
Residence Address - Street Alte Delogstrasse 26	Post Office Address - Street Alte Delogstrasse 26
City (Zip) 46483 Wesel	City (Zip) 46483 Wesel
State or Country Germany	State or Country Germany
Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>

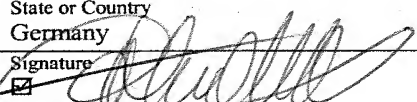
Second Joint Inventor, if any Valentino Villari	Citizenship Germany
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City (Zip) 41063 Mönchengladbach	City (Zip) 41063 Mönchengladbach
State or Country Germany	State or Country Germany
Date <input checked="" type="checkbox"/> 19.05.06	Signature <input checked="" type="checkbox"/> 

Third Joint Inventor, if any Tobias Roth	Citizenship Germany
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Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>

Fourth Joint Inventor, if any Nikolas Wirth	Citizenship Germany
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City (Zip) 48249 Dülmen	City (Zip) 48249 Dülmen
State or Country Germany	State or Country Germany
Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>



Fifth Joint Inventor, if any <b>Thomas Fenner</b>	Citizenship <b>Germany</b>
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State or Country <b>Germany</b>	State or Country <b>Germany</b>
Date <input checked="" type="checkbox"/> <b>19-05-06</b>	Signature <input checked="" type="checkbox"/> 

Sixth Joint Inventor, if any <b>Paul Hendrixx</b>	Citizenship <b>The Netherlands</b>
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City (Zip) <b>NL-5802 LE Venray</b>	City (Zip) <b>NL-5802 LE Venray</b>
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Date <input checked="" type="checkbox"/> <b>19-05-06</b>	Signature <input checked="" type="checkbox"/> 



## APPLICABLE RULES AND STATUTES

### 37 CFR 1.56. DUTY OF DISCLOSURE - INFORMATION MATERIAL TO PATENTABILITY (Applicable Portion)

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentability defines, to make sure that any material information contained therein is disclosed to the Office.

Information relating to the following factual situations enumerated in 35 USC 102 and 103 may be considered material under 37 CFR 1.56(a).

### 35 U.S.C. 102. CONDITIONS FOR PATENTABILITY: NOVELTY AND LOSS OF RIGHT TO PATENT

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraph (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

### 35 U.S.C. 103. CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER (Applicable Portion)

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

### 35 U.S.C. 112. SPECIFICATION (Applicable Portion)

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.



## DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY

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- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraph (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or
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All practitioners at Customer Number 04743

Send correspondence to: James P. Zeller

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State or Country <b>Germany</b>	State or Country <b>Germany</b>
Date <input checked="" type="checkbox"/> <b>24. July 2006</b>	Signature <input checked="" type="checkbox"/> <b>N. Wirth</b>



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Residence Address - Street <b>Schlossstrasse 139</b>	Post Office Address - Street <b>Schlossstrasse 139</b>
City (Zip) <b>46535 Dinslaken</b>	City (Zip) <b>46535 Dinslaken</b>
State or Country <b>Germany</b>	State or Country <b>Germany</b>
Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>

Sixth Joint Inventor, if any <b>Paul Hendrixx</b>	Citizenship <b>The Netherlands</b>
Residence Address - Street <b>Mambostraat 88</b>	Post Office Address - Street <b>Mambostraat 88</b>
City (Zip) <b>NL-5802 LE Venray</b>	City (Zip) <b>NL-5802 LE Venray</b>
State or Country <b>Germany</b>	State or Country <b>Germany</b>
Date <input checked="" type="checkbox"/>	Signature <input checked="" type="checkbox"/>



## APPLICABLE RULES AND STATUTES

### 37 CFR 1.56. DUTY OF DISCLOSURE - INFORMATION MATERIAL TO PATENTABILITY (Applicable Portion)

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentability defines, to make sure that any material information contained therein is disclosed to the Office.

Information relating to the following factual situations enumerated in 35 USC 102 and 103 may be considered material under 37 CFR 1.56(a).

### 35 U.S.C. 102. CONDITIONS FOR PATENTABILITY: NOVELTY AND LOSS OF RIGHT TO PATENT

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraph (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or
- (f) he did not himself invent the subject matter sought to be patented, or
- (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

### 35 U.S.C. 103. CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER (Applicable Portion)

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

### 35 U.S.C. 112. SPECIFICATION (Applicable Portion)

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.



**Appendix B**  
**to Statement of Facts Under 37 C.F.R. § 1.47(a)**  
**by Christine Davids**



**From:** aachen@jostarndt.de  
**Sent:** Friday, July 14, 2006 6:59 AM  
**To:** gmeyer  
**Subject:** Re: Re: Patent extension/deadlines?

Dear Professor Meyer,

Regarding patent application AC SCG 5307-PT-WO-US, the deadline for presenting the documents to the US Patent Office was 6/5/2006. With a payment of an official fee, an extension of this deadline could be applied for. Therefore, the signed documents are needed immediately for presentation to the Patent Office in the USA.

The same applies to patent application AC SCG 525 PEP-WO-US, but here the original deadline was 6/14/2006. Here too, the deadline can be extended against the payment of an appropriate official fee.

In the case of patent application AC SCG 5307-PT-WO-CA, the Patent Office of Canada has not yet assigned a deadline for presentation. Yet, here too, we would like to ask you to sign and return the documents as soon as possible.

Sincerely,  
In representation, Christine Davids

Jostarndt Patentanwalts-AG  
Brüsseler Ring 51  
D-52074 Aachen

Tel. 0241/40071 – 16  
Fax 0241/40071 – 21  
Email: aachen@jostarndt.de

---

**From:** gmeyer [mailto:gerhard.meyer@fh-gelsenkirchen.de]  
**Sent:** Sunday, July 9, 2006 18:10  
**To:** aachen@jostarndt.de  
**Subject:** Re: Patent extension/deadlines?

Dear Mrs. Bebronne,

Hereby I am supplying you with the following file names:

AC SCG 5307-PT-WO-US JO/CD  
AC SCG 5307-PT-WO-CA JO/CD  
ACSCG 5205 PEP-WO-US JO/CD



An assignment should be additionally possible via the outgoing mail.

Sincerely,

Gerhard Meyer

On 7/7/2006 at 16:40 <aachen@jostarndt.de> wrote the following:

Dear Professor Meyer

Unfortunately we cannot assign the files to your email. Please let us know the file numbers.

Sincerely,

Greetings

In representation Kornelia Bebronne

-----  
Kornelia Bebronne  
Jostarndt Patentanwalts-AG  
Brüsseler Ring 51  
D-52074 Aachen  
Tel. +49-241/40071118  
Fax +49-241-4007121  
k.bebronne@jostarndt.de

---

**From:** gmeyer [mailto:[gerhard.meyer@fh.gelsenkirchen.de](mailto:gerhard.meyer@fh.gelsenkirchen.de)]  
**Sent:** Thursday, July 6, 2006 19:57  
**To:** Information storage for public files (JODA)  
**Cc:** Kerstin Meyer  
**Subject:** Patent extension/deadlines?

Dear Dr. Jostarndt,

Unfortunately, due to the many deadlines towards the end of semester, and, among other things, my official visit to Romania from which I returned yesterday, I can only now respond to the above matter. Since in your letter no deadlines were named I'd like to ask you to inform me about the official deadlines and the deadline projections of your office.

Sincerely,

Gerhard Meyer



Prof. Dr. Gerhard Meyer  
Inorganic Chemistry and Materials

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Website [www.fan.re.fh-gelsenkirchen.de/menschen/meyer/meyer.aspx](http://www.fan.re.fh-gelsenkirchen.de/menschen/meyer/meyer.aspx)

Prof. Dr. Gerhard Meyer  
Inorganic Chemistry and Materials

FH Gelsenkirchen/University of Applied Sciences of Gelsenkirchen  
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E-mail [gerhard.meyer@fh-gelsenkirchen.de](mailto:gerhard.meyer@fh-gelsenkirchen.de)  
Website [www.fan.re.fh-gelsenkirchen.de/menschen/meyer/meyer.aspx](http://www.fan.re.fh-gelsenkirchen.de/menschen/meyer/meyer.aspx)



**From:** aachen@jostarndt.de  
**Sent:** Friday, July 14, 2006 6:59 AM  
**To:** gmeyer  
**Subject:** AW: AW: Patenterstreckung/Termine?

Sehr geehrter Herr Professor Meyer,

zur Patentanmeldung AC SCG 5307-PT-WO-US war die Frist zur Vorlage der Unterlagen beim US-Patentamt der 05.06.2006. Gegen Zahlung einer Amtsgebühr konnte eine Verlängerung dieser Frist beantragt werden. Die Dokumente werden daher umgehend unterzeichnet zur Vorlage beim Patentamt in den USA benötigt.

Das gleiche gilt für die Patentanmeldung AC SCG 525 PEP-WO-US, wobei hier ursprünglicher Fristablauf der 14.06.2006 war. Auch hier ist eine Fristverlängerung gegen Zahlung einer entsprechenden Amtsgebühr erfolgt.

Bei der Patentanmeldung AC SCG 5307-PT-WO-CA wurde bislang von Seiten des Patentamtes in Kanada keine Frist zur Vorlage des Assignments gesetzt. Jedoch bitten wir auch hier um baldmögliche Unterzeichnung und Rücksendung.

Mit freundlichen Grüßen

i.A. Christine Davids

Jostarndt Patentanwalts-AG  
Brüsseler Ring 51  
D-52074 Aachen

Tel. 0241 / 40071 - 16  
Fax 0241 / 40071 - 21  
email: aachen@jostarndt.de

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**Von:** gmeyer [mailto:gerhard.meyer@fh-gelsenkirchen.de]  
**Gesendet:** Sonntag, 9. Juli 2006 18:10  
**An:** aachen@jostarndt.de  
**Betreff:** Re: AW: Patenterstreckung/Termine?

Sehr geehrte Frau Bebronne,

hiermit möchte ich Ihnen folgende Aktenzeichen mitteilen:

AC SCG 5307-PT-WO-US JO/CD  
AC SCG 5307-PT-WO-CA JO/CD  
ACSCG 5205 PEP-WO-US JO/CD

Eine Zuordnung müsste zusätzlich über die Ausgangspost möglich sein.

Mit freundlichen Grüßen

Gerhard Meyer

Am 07.07.2006 um 16:40 schrieb <aachen@jostarndt.de> <aachen@jostarndt.de>:

11/2/2006



Sehr geehrter Herr Professor Meyer

leider können wir Ihre Email keine unserer Akten zuordnen. Bitte teilen Sie uns unser Aktenzeichen mit.

Vielen Dank und

viele Grüße

i. A. Kornelia Bebronne

-----  
Kornelia Bebronne  
Jostarndt Patentanwalts-AG  
Brüsseler Ring 51  
52074 Aachen  
Tel: +49-241-4007118  
Fax: +49-241-4007121  
k.bebonne@jostarndt.de

**Von:** gmeyer [mailto:gerhard.meyer@fh-gelsenkirchen.de]

**Gesendet:** Donnerstag, 6. Juli 2006 19:57

**An:** Informationsspeicher für Öffentliche Ordner (JODA)

**Cc:** Kerstin Meyer

**Betreff:** Patenterstreckung/Termine?

Sehr geehrter Herr Dr. Jostarndt,

leider kann ich aufgrund der vielfältigen Termine gegen Semesterende und u.a. meiner Dienstreise nach Rumänien, von der ich erst gestern zurückgekommen bin, erst jetzt auf die o.g. Angelegenheit zurückkommen.

Da in Ihrem Schreiben keine Termine genannt wurden, möchte ich Sie bitten, mich über die offiziellen Terminstellungen und die Terminvorstellungen Ihrer Kanzlei zu informieren.

Mit freundlichen Grüßen

Gerhard Meyer

Prof. Dr. Gerhard Meyer

Anorganische Chemie und Werkstoffe / Inorganic Chemistry and Materials

FH Gelsenkirchen / University of Applied Sciences of Gelsenkirchen

FB Angewandte Naturwissenschaften / Department of Applied Natural Sciences

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11/2/2006



Prof. Dr. Gerhard Meyer  
Anorganische Chemie und Werkstoffe / Inorganic Chemistry and Materials

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Website [www.fan.re.fh-gelsenkirchen.de/menschen/meyer/meyer.aspx](http://www.fan.re.fh-gelsenkirchen.de/menschen/meyer/meyer.aspx)



**Appendix C**  
**to Statement of Facts Under 37 C.F.R. § 1.47(a)**  
**by Christine Davids**



# GTW Attorneys

GTW Benzenbergstrasse 99-107 D-40229 Düsseldorf

Anwaltskanzlei  
Dr. Geyer & Borchert  
Christstrasse 25

44789 Bochum

per Telefax 0234-516 15 88

Jan-Marcel Grube (OLG)  
Fachanwalt für Arbeitsrecht  
Dr. Michael Terwiesene LL.M. (OLG)  
Fachanwalt für Verwaltungsrecht  
Dr. Falk Wurfale (OLG)  
Lehrstuhl für Bürgerliches Recht der Universität Dortmund  
für Arbeits-, Wirtschafts- und Versicherungsrecht  
Dirk Lohndorff (OLG)  
Doris Vorloper  
Dr. Ina Jansen  
Karsten Prote

7/18/06

301/04VO61 Je/A

Meyer J. Scheuten  
Your reference: 25461/04

Dear Colleague Raabe,

We make reference to your letter dated 6/13/2006, received by us on 6/19/2006.

1. Basically our client is ready to provide the required signature. However, first some questions must be clarified. Therefore, please let us know the date when the signature has to be provided.
2. Moreover, we had spoken about the participation clause according to Paragraph 7, Section 7 of the third-party contract "FireDevil" between your client and the state NRW, represented by FH Gelsenkirchen.

According to that, our client are entitled to 1% of the production price in case of industrial production and based on the fire protection laminates developed based on the project. If your client should issue a production license, our client receives 1% of the net license amount.

The products in which the Patents EP 1 398 147 "Fire protection vitrification unit" and EP 1 431 027 "Fire protection means and methods for its preparation" are utilized have reached the production stage in the meantime. Based on this background, the participation amount according to Paragraph 7, Section 7 of the above-mentioned third-party contract will become due shortly.

As you know, the business relationship between your client and our client is tense. Our client is afraid that the participation payments due will not be paid or will not be paid in the full amount. Against this background, our client obtained a counsel's opinion to check the legality of the above third-party contract and the legal position with regard to a cancellation of the contract. As a result of this counsel's opinion, it was found that the execution of the right to cancellation seems promising. Independently of that, our client has the possibility of having the production prices of the above-mentioned patents and the resulting claims of payment derived from them be checked by an independent certified



public accountant. This procedure would have to be repeated annually in the coming years.

Against this background, we consider it expedient to agree out of court comparatively on a single advance payment to satisfy the requirements of Paragraph 7, Section 7 of the third-party contract. With such a payment all claims arising from the legal relationship can be compensated and your client could go into production without a certified public accountant having to check the numbers every year.

Our client predicted the production costs for the coming 10 years (attachment). According to this, an estimated amount of € 932,637.00 would be due to our client. The predictions are based on a first production installation, which produces laminates in a width of 2.40 m (or 2.20 m). However, installations are also customary in which the width is 3.21 m. If the latter installations were used, the predictions would increase correspondingly based on the expanded production.

Furthermore to be considered are any license fees for Japan and the USA, among others.

Besides that, our client is due a monthly a lump-sum payout according to competition agreement 1.H of € 1,227.10, that is, a total of € 29,450.40.

Based on these data we propose for a comparative satisfaction of the requirements arising from Paragraph 7, Section 7 of the third-party contract "FireDevil," an amount of

€ 750,000.00

which would be paid by your client to our client.

Furthermore we take the liberty of mentioning that our client does not know that even one employee of the company Scheuten has provided a proven inventive output during the time of the contract in the area of fire protection.

Please let us know if on the side of your client there is a readiness to make an agreement such as that described above. For this purpose we are ready to discuss the entire subject in a joint meeting. Under certain circumstances it might also be expedient to include the Technical University Gelsenkirchen in a joint discussion in order to clarify any outstanding questions in this regard as well.

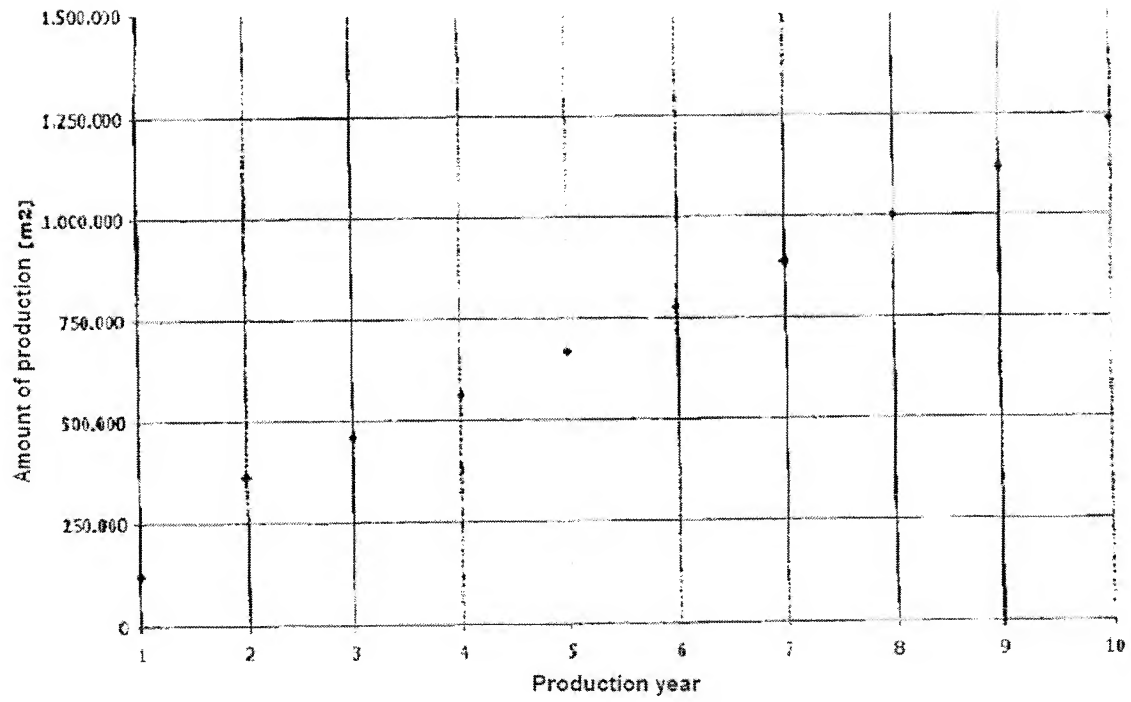
We are hoping for an early reply regarding your position.

Sincerely

(Signature)  
Vorloeper  
Attorney



### Production development (Fire protection laminate)





Production development of fire protection laminates expected (moderate technological progress)									
Parameter	1 <sup>st</sup> year	2 <sup>nd</sup> year	3 <sup>rd</sup> year	4 <sup>th</sup> year	5 <sup>th</sup> year	6 <sup>th</sup> year	7 <sup>th</sup> year		
Effective working width [m]	2.2	2.2	2.2	2.2	2.2	2.2	2.2		
Speed [m/min]	0.30	0.40	0.50	0.60	0.70	0.80	0.90		
Installation availability [h]	3840	8064	8064	8064	8064	8064	8064		
Layer system	2-layer	4-layer	4-layer	4-layer	4-layer	4-layer	4-layer		
Quality [%]	80	85	86.5	88	89.5	91	92.5		
Total amount of laminate [m <sup>2</sup> ]	121,651	361,912	460,374	562,029	666,877	774,918	886,153		
Laminate cost [€/m <sup>2</sup> ]	15	15	14	14	14	13	13		
Total cost of laminate [€]	1,824,768	5,292,968	6,564,642	7,813,821	9,039,726	10,241,656	11,418,989		
1% cost [€]	18,248	52,930	65,646	78,138	90,397	102,417	114,190		
Parameter	8 <sup>th</sup> year	9 <sup>th</sup> year	10 <sup>th</sup> year	Participation in sales (total)					
Effective working width [m]	2.2	2.2	2.2						
Speed [m/min]	1.00	1.10	1.20						
Installation availability [h]	8064	8064	8064						
Layer system	4-layer	4-layer	4-layer						
Quality [%]	94	95.5	97						
Total amount of laminate [m <sup>2</sup> ]	1,000,581	1,118,203	1,239,017						
Laminate cost [€/m <sup>2</sup> ]	13	12	12						
Total cost of laminate [€]	12,571,175	13,697,733	14,789,246						
1% cost [€]	125,712	136,977	147,982	932,637					



18/07 2006 TUE 16:11 FAX 021193889922 GTW Rechtsanwälte

001/004

**GTW** 

Rechtsanwälte

GTW Benzenbergstraße 39-47 D-40219 Düsseldorf

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Lehrbeauftragter an der Universität Dortmund  
für Bau-, Architekten- und Vergabericht  
Birte Lohle-Dittrich (OLG)  
Doris Verloopper  
Dr. Ira Janzen  
Karsten Proteper Telefax 0234 - 516 15 8818.07.06  
301/04VO61 Je/AMeyer ./ Scheuten  
Ihr Zeichen: 25461/04

Sehr geehrter Herr Kollege Raabe,

Wir nehmen Bezug auf Ihr Schreiben vom 13.06.2006, hier eingegangen am 19.06.2006.

1. Dem Grunde nach ist unsere Mandantschaft bereit, die erforderliche Unterschrift zu leisten. Allerdings müssen vorab noch einige Fragen geklärt werden. Lassen Sie uns daher bitte wissen, bis wann die Unterschrift vorliegen muss.

2. Darüber hinaus hatten wir über die Beteiligungsklausel gem. § 7 Abs. 7 des Drittmittelvertrages „FireDevil“ zwischen Ihrer Mandantschaft und dem Land NRW, vertreten durch die FH Gelsenkirchen, gesprochen.

Danach steht unserer Mandantschaft bei einer industriellen Produktion und aufgrund des Projektes entwickelten Brandschutzlaminaten 1% des Produktionspreises zu. Sollte Ihre Mandantschaft eine Produktionslizenz vergeben, erhält unsere Mandantschaft 1% der Netto lizenzsumme.

Die Produkte, in denen die Patente EP 1 398 147 „Brandschutzverglasungseinheit“ und EP 1 431 027 „Brandschutzmittel und Verfahren zu seiner Herstellung“ verwertet wurden, sind zwischenzeitlich zur Produktionsreife gelangt. Vor diesem Hintergrund wird in Kürze die Beteiligungssumme gem. § 7 Abs. 7 des oben genannten Drittmittelvertrages fällig werden.

Wie Sie wissen, ist die geschäftliche Beziehung zwischen Ihrer Mandantschaft und unserer Mandantschaft angespannt. Unsere Mandantschaft befürchtet, dass die anstehenden Beteiligungszahlungen nicht oder nicht in voller Höhe ausbezahlt werden. Vor diesem Hintergrund hat unser Mandant ein Rechtsgutachten in Auftrag gegeben, die Rechtsfähigkeit des o.g. Drittmittelvertrages und die Rechtslage in Bezug auf eine Rückabwicklung des Vertrages zu

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Telefon +49 (0) 211/93 88 99 21 Telefax +49 (0) 211/93 88 99 22 www.g-t-w.de mail@g-t-w.de

HypoVereinsbank Düsseldorf BLZ 302 20190 Konto 44 66 900 USt-ID-Nr. DE 214318296



18/07 2006 TUE 16:11 FAX 021193889922 GTW Rechtsanwälte

002/004

## GTW

überprüfen. Im Ergebnis dieses Gutachtens wurde festgestellt, dass die Ausübung des Rücktrittsrechts aussichtsreich erscheint. Unabhängig davon hat unser Mandant die Möglichkeit, die mit den vorbenannten Patenten erzielten Produktionspreise und daraus abgeleiteten Zahlungsansprüche von einem unabhängigen Wirtschaftsprüfer überprüfen zu lassen. Diese Prozedur müsste jährlich in den kommenden Jahren wiederholt werden.

Vor diesem Hintergrund halten wir es für sinnvoll, sich außergerichtlich vergleichsweise auf eine einmalige Abschlagszahlung zur Abgeltung der Forderungen aus § 7 Abs. 7 des Drittmittelvertrages zu einigen. Mit einer vergleichweisen Regelung könnten alle Ansprüche aus dem Rechtsverhältnis abgegolten werden und Ihre Mandantschaft könnte in die Produktion gehen, ohne dass jährlich ein Wirtschaftsprüfer die Zahlen überprüft.

Unsere Mandantschaft hat die Produktionspreise für die kommenden 10 Jahre prognostiziert (Anlage). Danach stünde unserer Mandantschaft insgesamt ein Betrag in Höhe von geschätzt 932.637,00 € zu. Die Prognosen beziehen sich auf eine erste Produktionsanlage, die Laminare in einer Breite von 2,40 m (bzw. 2,20 m) herstellt. Üblich sind aber Anlagen, bei denen die Breite 3,21 m beträgt. Sollten letztere Anlagen zum Einsatz kommen, wären die Prognosen aufgrund der erweiterten Produktion entsprechend zu erhöhen.

Weiter zu berücksichtigen sind etwaige Lizenzgebühren unter anderem für Japan und die USA.

Außerdem steht unserer Mandantschaft aus der Wettbewerbsvereinbarung eine monatliche Abfindungszahlung i. H. v. 1.227,10 € zu, mithin insgesamt 29.450,40 €.

Ausgehend von diesen Daten schlagen wir zur vergleichweisen Abgeltung der Forderungen aus § 7 Abs. 7 des Drittmittelvertrages „FireDevil“ einen Betrag in Höhe von

**750.000,00 €**

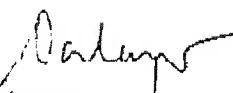
vor, der von Ihrer Mandantschaft an unseren Mandanten zu zahlen wäre.

Ferner erlauben wir uns den Hinweis, dass unserem Mandanten nicht bekannt ist, dass auch nur ein Mitarbeiter der Fa. Scheuten während der Vertragslaufzeit eine nachweisbare Erfindung im Brandschutzbereich erbracht hat.

Lassen Sie uns bitte wissen, ob auf Seiten Ihrer Mandantschaft die Bereitschaft besteht, sich in dem oben genannten Sinne zu einigen. Gerne sind wir zu diesem Zweck auch bereit, den gesamten Themenkomplex in einer gemeinsamen Besprechung zu erörtern. Unter Umständen wäre es auch sinnvoll, zu einer gemeinsamen Besprechung die Fachhochschule Gelsenkirchen heranzuziehen, um die in diesem Verhältnis noch offenen Fragen ebenfalls zu klären.

Ihrer kurzfristigen Stellungnahme sehen wir entgegen.

Mit freundlichen kollegialen Grüßen

  
Vorloeper  
Rechtsanwältin



18/07 2006 TUE 16:11 FAX 021193889922 GTW Rechtsanwälte

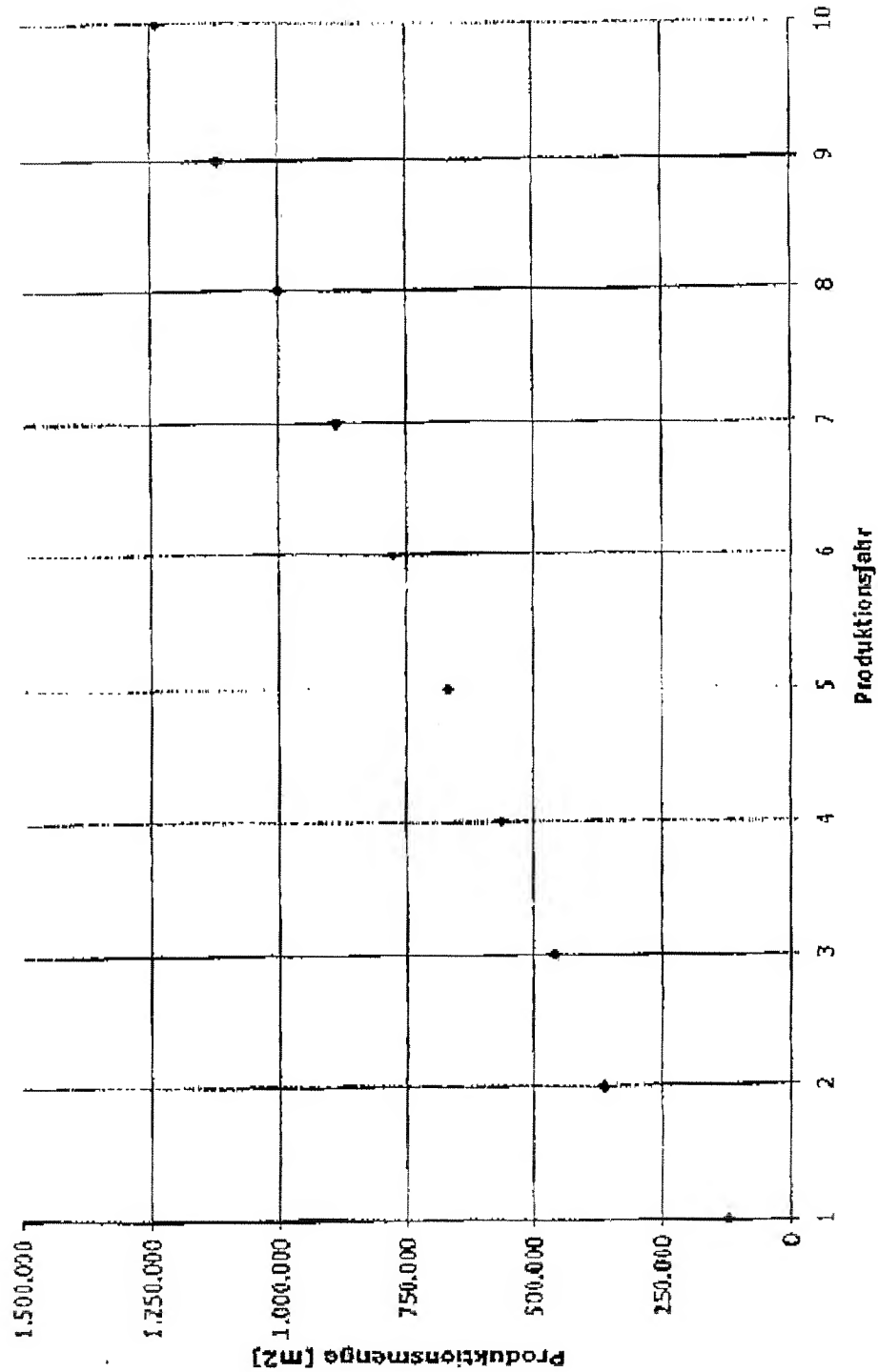
09 Jul 06 18:20

Gerhard Meyer

02919009319

S. 2

Produktionsentwicklung (Brandschutz-Laminat)





18/07 2006 TUE 16:12 FAX 021193889922 GTW Rechtsanwalt

00 Jul 66 10:21

gerhard meyer

02813003318

5.2

Zu erwartende Produktionsentwicklung von Brandschutz-Laminaten (mäßiger Technologiefortschritt)									
Parameter	1. Jahr	2. Jahr	3. Jahr	4. Jahr	5. Jahr	6. Jahr	7. Jahr		
Arbeitsbreite eff. [m]	2,2	2,2	2,2	2,2	2,2	2,2	2,2		
Vorschub [m/min]	0,30	0,40	0,50	0,60	0,70	0,80	0,90		
Anlagenverfügbarkeit h	3840	8064	8064	8064	8064	8064	8064		
Schlichtsystem	2-Schicht	4-Schicht	4-Schicht	4-Schicht	4-Schicht	4-Schicht	4-Schicht		
Qualität [%]	80	85	85,5	88	89,5	91	92,5		
Laminat-Gesamtmenge [m <sup>2</sup> ]	121.651	361.912	460.374	562.029	666.877	774.918	886.153		
Laminat-Kosten [€/m <sup>2</sup> ]	15	15	14	14	14	13	13		
Laminat-Gesamtkosten [€]	1.824.768	5.292.968	6.564.642	7.813.821	9.039.726	10.241.656	11.418.989		
1%-Kosten [€]	18.248	52.930	65.646	78.138	90.397	102.417	114.190		
Parameter	8. Jahr	9. Jahr	10. Jahr	Umsatzbeteiligung					
Arbeitsbreite eff. [m]	2,2	2,2	2,2	(gesamt)					
Vorschub [m/min]	1,00	1,10	1,20						
Anlagenverfügbarkeit h	8064	8064	8064						
Schlichtsystem	4-Schicht	4-Schicht	4-Schicht						
Qualität [%]	94	95,5	97						
Laminat-Gesamtmenge [m <sup>2</sup> ]	1.000.581	1.118.203	1.239.017						
Laminat-Kosten [€/m <sup>2</sup> ]	13	12	12						
Laminat-Gesamtkosten [€]	12.571.175	13.697.733	14.798.246						
1%-Kosten [€]	115.712	136.977	147.982	932.637					



**Appendix D**  
**to Statement of Facts Under 37 C.F.R. § 1.47(a)**  
**by Christine Davids**





RECHTSANWÄLTE UND NOTARE

ZUSAMMENSCHLUSS DER SOZIALFACHEN REDDEMANN, BORCHERT, RAABE, DEPKA & COLLEGEN UND DR. GEYER & SCHWARZHOF

DR. GEYER & BORCHERT

ESSEN · BOCHUM · DORTMUND

RAE DR. GEYER & BORCHERT, CHRISTSTRASSE 25, 44789 BOCHUM



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Jostarndts Patentanwalts-AG  
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52074 Aachen

per Fax: 0241/400 71-21

UNSER AKTENZEICHEN

50229/06

Scheuten ./ Meyer

SACHBEARBEITER

RA Raabe

DATUM

09.10.06

TE/D9151

BOCHUM

KLAUS-PETER RAABE  
RECHTSANWALT "

REINER DEPKA  
RECHTSANWALT UND NOTAR "

UWE BORCHERT  
RECHTSANWALT "

ANDREAS POSER  
RECHTSANWALT " 1)

DR. MARTIN SCHICK  
RECHTSANWALT " 1)

BASTIAN JUNGHÖLTER  
RECHTSANWALT

LOTHAR REDDEMANN  
RECHTSANWALT (BIS 3.2.99)

ESSEN

MANFRED SCHWARZHOF  
RECHTSANWALT UND NOTAR "

DR. DIETHARD GEYER  
RECHTSANWALT (BIS 31.12.04)  
JETZT RA IN STRALSUND

DORTMUND

THOMAS ROGOWSKI  
RECHTSANWALT "

DR. KLAUS STEFENER  
RECHTSANWALT "

- 1) AUCH ZUGELASSEN BEI DEN  
OBERLANDESGERICHTEN
- 2) FACHANWALT FÜR ARBEITSRECHT
- 3) FACHANWALT FÜR STEUERRECHT

Scheuten ./ Meyer

Ihr Zeichen: AC SCG 5307-PT-WO-US JO/CD

Dear Mr. Jostarndt,

in the case mentioned above concerning the patent application and especially Prof. Meyer I am able to tell you the following.

The existing documents at our office show that you ask Prof. Meyer on July 14th 2006 to sign the patent application.

This application includes also the patent No. ACSCG 5205 PEP-WO-US. Consequently I wrote letter to the advocates of Prof. Meyer dated September, 9th 2006 including the information that Prof. Meyer has to sign immediately to avoid indicial disadvantages.

I suggested to meet for a discussion on September 20th, 21st or 22nd. At first there was no reaction to any letter.

With a second letter on September 26th, 2006 I wrote again to the advocates and told them that there is a deadline concerning No.10/539,877 on November 14th, 2006. I also announced in this letter our right of restitution if Prof. Meyer would not have signed the application.

I offered a discussion in a meeting until October 10th, 2006.

DEUTSCHE BANK DATTELN · BLZ 420 700 24 · KONTO 663 8613 00  
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STEUERNUMMER: 306/5070/0992 · UST-IDENT-Nr.: DE 194172212



Seite: 2 zum Schreiben Dr. Geyer & Borchert

Then I received a letter of Prof. Meyers advocates (dated 28th September) containing the information that the advocates are still waiting for a reaction of their client.

Since then there was no further contact.

It seems that there is no interest of Prof. Meyer to sign the patent application but there was no express rejection. The only explanation of himself was in the letter of July 18th, 2006 that we enclose to this letter.

On principle, he wrote, he would sign the application but there are some questions that must be answered before.

Until now he has not explained these questions. Otherwise he made demands against Fa. Scheuten in the same letter about 750.000,00 €.

Yours sincerely,

